

REMARKS

As a preliminary matter, Applicants thank Examiner Lea for the courtesy extended during the telephone interviews on January 8 and 12, 2010 with Applicants' representative. Applicants are grateful that all the pending claims are deemed to be allowable pending the execution of a Terminal Disclaimer.

Claims 70-85, 87-96, and 98-105 are pending in the present application. Early allowance of this application is respectfully requested.

I. PRIORITY

The Examiner suggests that the errors on the existing ADS relating to the priority of the present application be corrected. In response, Applicants submit herewith a clean copy and a marked-up copy of a revised ADS setting forth the correct chain of priority. Concurrently submitted is a Request to Correct Inventorship Under 37 C.F.R. § 1.48(b) to delete David Sackler as a co-inventor. Other sections of the ADS, for example, the attorney docket number, the applicant information, the correspondence information and the assignee information, have also been updated.

II. THE DOUBLE PATENTING REJECTION SHOULD BE WITHDRAWN

The pending claims are rejected under the judicially created doctrine of obviousness-type double patenting over various claims of U.S. Patent Nos. 5,958,452 (claims 1-16, 18-24, 26-32, 41-50 and 62-66), 5,965,161 (claims 1, 3-5, 8-11, 15-21, 24-31, 33, 37, 39, 41, 46-53 and 57-66), 6,261,599 (claims 1-8, 10-25 and 27), 6,335,033 (claims 1-5, 8-21, and 24-37), 6,706,281 (claims 1, 4, 7-17, 19, 22, 24-33 and 35-37), 6,743,442 (claims 1-8, 10-24, 27-29 and 32), and 7,510,727 (claims 1-5, 7, 15-21, 23-27 and 29) (collectively, "double patenting references"), and, provisionally, over claims of copending U.S. Application No. 12/372,460 (claims 1, 35 [*sic*, 3, 5], 8-17, 19, 28, 31 and 33). The Examiner contends that although the conflicting claims are not identical, they are not patently distinct from each other because both are drawn to an extruded particulate opioid formulation comprising hydromorphone with hydrophobic materials and fusible carriers, as well as methods of making and/or using the same.

Although Applicants disagree with this rejection, solely to expedite the prosecution of this application, Applicants submit herewith a Terminal Disclaimer disclaiming the terminal portion of the statutory term of any patent granted on this application over the terms of the above double patenting references and of any patent granted on its copending U.S. Application No. 12/372,460. Applicants further submit that filing of this Terminal Disclaimer is not an admission of obviousness. *See Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1336-37 (Fed. Cir. 2004) (holding that no inference of obviousness should be drawn from a terminal disclaimer). As such, the nonstatutory obviousness-type double patenting rejection is believed to be obviated and should be withdrawn.

CONCLUSION

It is respectfully requested that the above remarks be entered into the file of the application. Should the Examiner not agree with Applicants' position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

No other fees are believed to be due for this submission. If any fees are due, please charge the required fees to Jones Day Deposit Account No. 50-3013.

Date: February 1, 2010

Respectfully submitted,


Susie S. Cheng

(Reg. No. 46,616)

JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939

Enclosures